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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,294	09/07/1999	RICHARD C. WILSON	CBC-122-C	8383

7590 06/17/2009
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EXAMINER

CANFIELD, ROBERT

ART UNIT	PAPER NUMBER
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3600

MAIL DATE	DELIVERY MODE
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06/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/391,294	Applicant(s) WILSON ET AL.	
	Examiner ROBERT J. CANFIELD	Art Unit 3600	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>translation FR 572.198</u> |

1. This Office action is in response to the amendments received 08/04/08, 10/09/08 and 03/02/09. Claims 1-10 are pending.

2. While there is concurrent litigation related to this reissue application, action in this reissue application will **NOT** be stayed because it is evident to the examiner that it is applicant's desire that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED and in accordance with MPEP 1442.01 a **(1) ONE MONTH** period for reply has been set.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

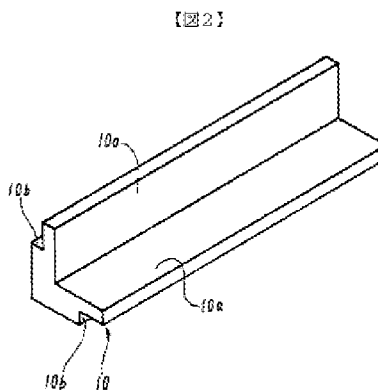
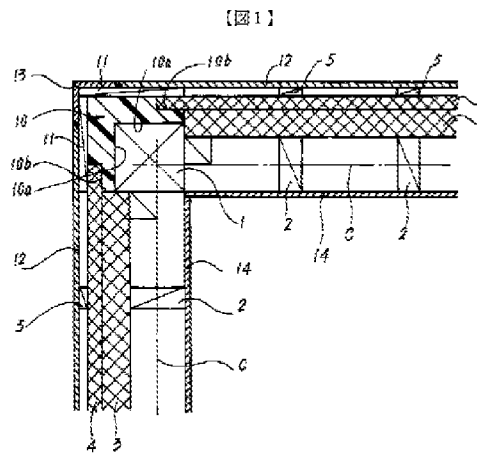
The language "the cornered outer surface is flat and planar" is indefinite. It is unclear how the surface can be both "cornered" and "flat and planar". The language used in independent claims 5, 6 and 10 clearly defines the cornered outer surface as being defined by a pair of flat planar surface joined at a corner".

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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6. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan 5-112990.

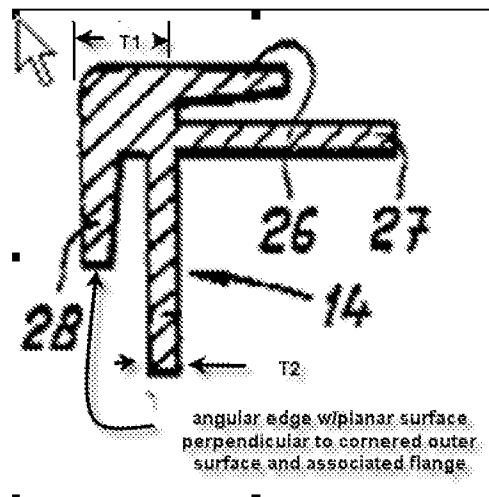
The Japanese reference provides an insulation outside building corner element (10) as shown in figures 1 and 2 that includes all of the claimed structural features of the instant claims and which is made from molded polystyrene foam (from English Abstract). The member 10 is capable of being used with a corner post of thin sheet material.



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7. Claims 1, 2, 4 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,964,252 to Guliker.

Member 14 of Guliker has all of the claimed structural features and inherently has insulating qualities. As the member has all of the claimed structure of applicants member it is inherently capable of being used with a corner post. The thickness T2 of the flanges is less than the thickness defined between the spaced apart inner and outer corners.

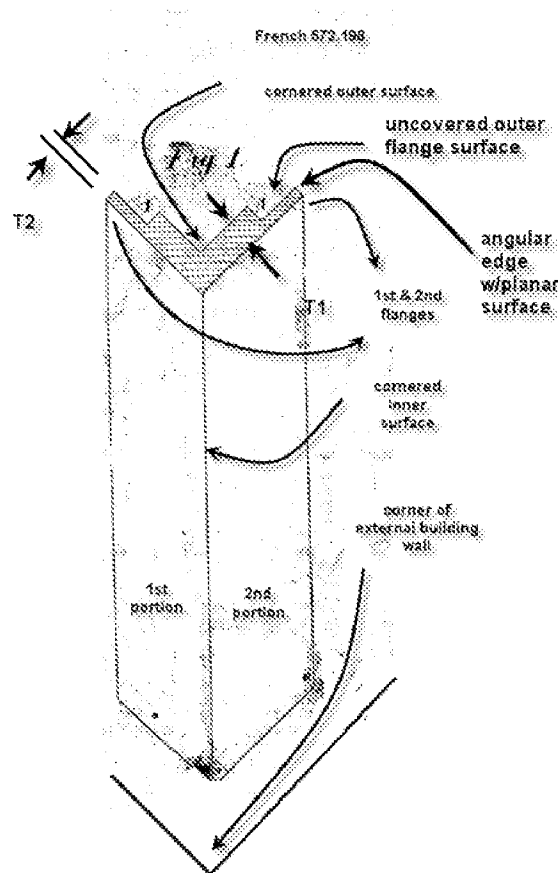


8. Claims 1, 2, 4-7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by French Patent 572.198.

The French patent provides a single member formed of material which is homogeneous/uniform through as illustrated in the cross section. The first and second portions are angularly disposed from each other defining a cornered inner surface and a cornered outer surface substantially parallel to the cornered inner surface. First and second flanges extend continuously along the entire

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length of the portions and extend continuously from the inner surface of the portions and form a detent with the outer surface. The material of the member inherently would have insulating qualities. The member is capable of being used with a corner post at a corner of an external wall of a building and has lengths capable of corresponding to the length of a corner of a building. The thickness of the flanges T2 is less than the thickness of the first cross sectional thickness T1. The outer surface of the flanges are not covered by any portion of the single member.



9. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 572.198 in view of U.S. Patent 5,140,794 Miller.

The French patent is directed to construction system having double angles, posts and plates for forming walls of predetermined thickness where the gap that exists between the plates and posts is filled with slag concrete, lime, sand, clinker, pebbles or gravel. This system is essentially a forming system. The disclosed angles (figure 1) provide all of the claimed structure but fail to provide the claimed material. The angles (figure 1) of the French patent are disclosed as being made from reinforced concrete.

Miller teaches that at the time of the invention it was known to use polystyrene foam in forming systems for its highly desirable features such as light weight, rigidity and thermal insulation (col. 1, lines 24027).

It would have been obvious at the time of the invention to one having ordinary skill in the art that the member of the French patent could have been made out of material such as molded or extruded polystyrene foam as polystyrene foam is recognized as a suitable material for use in the forming of wall systems for its desirable properties as taught by Miller.

It would have been an obvious material choice for its inherently material properties such as its high insulating value and there would have been no unexpected or unpredictable results achieved by making a corner member having the structure of the French patent out of a polystyrene material.

10. Claims 1-10 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175.

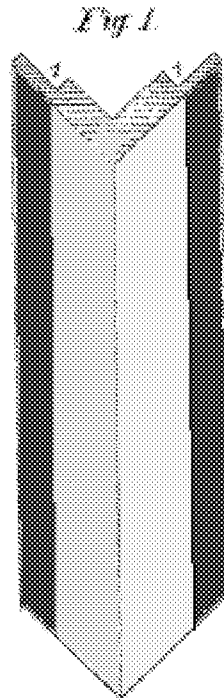
Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

See MPEP § 1414.01.

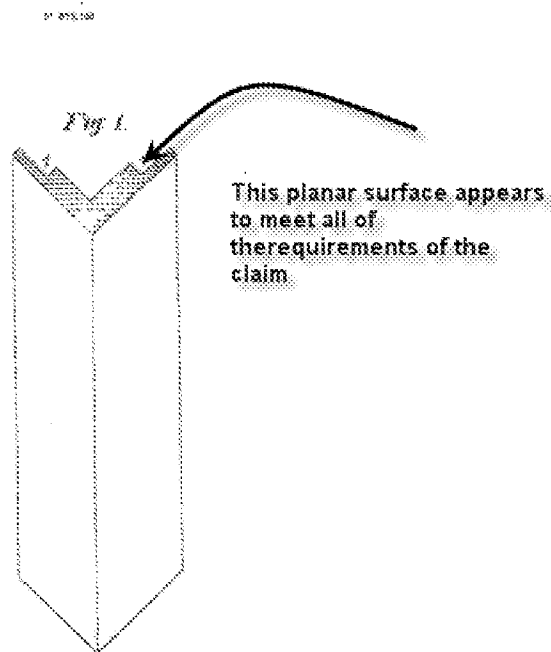
11. Applicant's arguments filed 08/04/08, 10/09/08 and 03/02/09 have been fully considered but they are not found fully persuasive.

Applicant argues that the French reference fails to teach the first and second flanges extend contiguous and coplanar with the associated inner cornered surface. This is not persuasive because as noted in the previous and above rejections the inner cornered portion is considered the corner/portions/surfaces facing the reader in figure 1. The first and second flanges are clearly contiguous and coplanar with the cornered inner surface as further illustrated by shading below.



There is nothing in the claims to preclude the examiner for considering this surface to be the inner cornered surface.

Applicant further argues that the cornered outer surface terminates in an angular edge that has a planar surface contiguously connected thereto, the planar surface oriented essentially perpendicular to the cornered outer surface and essentially perpendicular to the opposed outer surface of the associated flange.



Applicant's argument that Guliker fails to teach or suggest the features of claim 1 fails to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

The argument that the substitution of polystyrene for the cement material in the French because polystyrene has limited ability to withstand the strain that would be imparted in the system of the French patent is not found persuasive as the examiner has provided a secondary teaching that polystyrene was a known material at the time of the invention for use in form wall systems for its desirable properties such as light weight, rigidity and thermal benefits. The secondary teaching is also directed to a form wall system to be filled with concrete which would also be under similar stresses. The examiner maintains that there would

have been no unexpected or unpredictable results for making the elements of the French patent out of a polystyrene material.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 4,433,520 to Maschhoff teaches several embodiments of corner members used in a form system where the members are disclosed as being made from wood.

U.S. Patent 4,972,646 to Miller et al. teaches that expanded polystyrene foam was a known equivalent material to wood in forming systems.

U.S. Patent 5,404,685 to Collins teaches that polystyrene was a known material for use in structural columns and wall panels.

U.S. Patent 4,270,302 to Dandia teaches that polystyrene corner members 22 were known at the time of the invention.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

A shortened statutory period for reply to this final action is set to expire **ONE** **MONTH** from the mailing date of this action.

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14. Any inquiry concerning this communication should be directed to ROBERT J. CANFIELD at telephone number (571)272-6840.

Robert J Canfield
SPE
Art Unit 3635

/Robert J Canfield/

Supervisory Patent Examiner, Art Unit 3635